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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,569	03/04/2005	Yoshihiro Ohmiya	SAEG129.010APC	4231
20995 7590 04/17/2008 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER ROBINSON, HOPE A				
ART UNIT		PAPER NUMBER		
1652				
NOTIFICATION DATE		DELIVERY MODE		
04/17/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
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Office Action Summary

Application No.

10/526,569

Applicant(s)

OHMIYA ET AL.

Examiner

HOPE A. ROBINSON

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-12, 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-12, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/888)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Application Status

1. Applicant's response to the Office Action mailed on August 29, 2007 on December 28, 2007 is acknowledged.

Claim Disposition

2. Claims 17-18 have been added. Claims 9-12 and 17-18 are pending and are under examination.

Specification

3. The following rejections are or remain applicable:

Maintained and Amended-Claim Rejections - 35 USC 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 9-12 and 17-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 9-12 and 17-18 are drawn to a polynucleotide,

which reads on a product of nature. The claims should be amended to indicate the hand of the inventor, for example the insertion of "isolated" or "purified" in connection with the DNA to identify a product not found in nature (see MPEP 2105).

Maintained and Amended-Claim Rejections - 35 USC 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 9-12 and 17-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claimed invention is directed to a polynucleotide encoding a secretory or membrane-binding chimeric protein, however, the specification lacks adequate written description to demonstrate to a skilled artisan that applicant was in possession of the claimed invention. Claim 9 for example, is devoid of a structure and is only defined by the activity of encoding a protein. The claims are directed to a genus of DNA and proteins. Claim 9 has been amended to recite *Vargula luciferase* for example, however, no correlation is made between structure and function in the claim. Therefore, the skilled artisan cannot envision the detailed chemical structure of the

chimeric polypeptides encoded or the encoding nucleic acid absent guidance. It is noted that claim 18 recites a structure for the encoded protein, however, with the open language "having" and the recited "an amino acid sequence represented by SEQ ID NO:1" the claim reads on a dipeptide, thus encompasses a genus of fragments and variants. In addition, claim 17 is directed to a peptide to be inserted inside or between structures not provided in claim 9, nor does claim 17 provide a structure for the recited peptide.

The specification fails to provide any additional representative species of the claimed genus to show that applicant was in possession of the claimed genus.

A representative number of species means that the species, which are adequately described are representative of the entire genus. The written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice, disclosure of drawings, or by disclosure of relevant identifying characteristics, for example, structure or other physical and/or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the claimed genus.

Accordingly, in the absence of sufficient recitation of distinguishing identifying characteristics, the specification does not provide adequate written description of the claimed genus. Further, *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir.1991), states that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in *possession of the invention*. The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed*" (See page 1117).

The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed" (See *Vas-Cath* at page 1116). The skilled artisan cannot envision the detailed chemical structure of the encompassed genus of products, and therefore, conception is not achieved until reduction to practice has occurred, regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method of isolating it. The compound itself is required. See *Fiers v. Revel*, 25 USPQ2d 1601 at 1606 (CAFC 1993).

Therefore, for all these reasons the specification lacks adequate written description, and one of skill in the art cannot reasonably conclude that the applicant had possession of the claimed invention at the time the instant application was filed.

Response to Arguments

6. The response filed has been considered in full, however, is not persuasive. With respect to the objections of record, the amendments made obviated the objections, thus applicant's comments are moot and will not be addressed herein. Note, however, that the rejection under 35 U.S.C. 101 remains and applicant's comments regarding the protein product being recombinantly made is not persuasive. As such the claim should be amended to recite that limitation and furthermore, the claimed invention is to the polynucleotide. As natural mutations can occur the recited "polynucleotide" should have a qualifier of "isolated or purified". Note that this rejection has also been applied to newly added claims 17 and 18.

Regarding the rejection under 35 U.S.C. 112, first paragraph, note that only the written description portion remains based on the amendments made to the claims. Applicant's arguments

have been considered, however are not fully persuasive. It is noted that newly submitted claim 18 recites a structure that is missing from claim 9, however, this is only a partial fix. Firstly, claim 9 needs to stand on its own as an independent claim and secondly, claim 18 is directed to fragments and variants of SEQ ID NO:1, thus has its own written description problem with the recitation of "...having an amino acid sequence represented by SEQ ID NO:1". No real correlation is made between structure and function. It is noted that applicant's provided a reference from 2004 (Nakajima et al.), however, this represents post filing materials and applicant needs demonstrate possession of the claimed invention at the time the instant application was filed. Thus, the rejection remains.

Conclusion

7. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. No claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HOPE A. ROBINSON whose telephone number is (571)272-0957. The examiner can normally be reached on Monday-Friday 9:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nashaat T. Nashed, can be reached at (571) 272-0934. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Hope A. Robinson/

Primary Examiner, Art Unit 1652

